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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sudhir Malhotra et al.

Title: Magnetic Recording Medium Having Novel Underlayer Structure

Serial No.: 10/761,820

Filed: 1/21/04

Examiner: H. Rickman

Art Unit: 1773

Docket No.: K2003010

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Applicant submits herewith an Amendment. The fee for this Amendment is

calculated below:

	<u>Previously paid for</u>	<u>Total number of claims</u>	<u>New claims</u>	<u>Fee per claim</u>	<u>Total Fee</u>
Independent Claims	3	3	0	200	0
Total Claims	35	24	11	50	550
Total Fee:					\$550

Applicant submits herewith a check for \$550. The Commissioner is requested to deduct any other required sums, or credit any overpayment, to deposit account 500794.

Respectfully submitted,

Kenneth E. Leeds

Reg. No. 30,566

Attorney for Applicants

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 1, 2006.

March 1, 2006

Date

Signature



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Malhotra et al.

Title: Magnetic Recording Medium Having Novel Underlayer Structure

Serial No.: 10/761,820

Filed: January 21, 2004

Examiner: Holly C. Rickman

Art Unit: 1773

Docket No.: K2003010

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

AMENDMENT

In response to the Office Action dated December 12, 2005, please amend the claims as set forth in Exhibit A attached hereto.

REMARKS

I. Claims 3, 13 and 20 Satisfy the Definiteness Requirement of 35 USC 112

The Examiner rejected claims 3, 13 and 20, because she considered the phrase “underlayers substantially lack boron” unclear. Office Action, ¶2. Applicants traverse this rejection. Phrases of this nature are consistently held to comply with 35 USC 112. For example, in Bausch & Lomb, Inc. v. Alcon Lab., Inc., 79 F. Supp. 2d 243, 53 USPQ2d 1353 (W.D.N.Y. 1999), the Court discussed a survey of claims containing language describing something as “substantially free of” particular materials. This type of language satisfied the definiteness requirements of 35 USC 112.¹

¹ While the language “underlayers substantially lack boron” satisfies the definiteness requirement of 35 USC 112, if the Examiner prefers the language “substantially free of boron”, Applicants are willing to substitute this phrase.